



UNITED STATES PATENT AND TRADEMARK OFFICE

43

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,812	10/30/2003	Tania W. Hanna	43562.0300	9579

7590 10/22/2004

Lance L. Vietzke
Snell & Wilmer
400 East Van Vuren
Phoenix, AZ 85004-2202

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
----------	--------------

3751

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,812

Applicant(s)

HANNA, TANIA W.

Examiner

Kathleen J. Prunner

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-17,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-17, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4, 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser. Bolser discloses a holder (constituted by coupling element 13) having the claimed features including a main body having a first end and a second end (note Fig. 2), the first end having a first holder for releasably holding a first cosmetic tool 11 (note lines 60-63 in col. 1) wherein the first holder provides for a friction fit between the first end and the first cosmetic tool 11 (note lines 63-65 in col. 1) and wherein the first cosmetic tool 11 is a conventional cosmetic tool designed for use as a separate unit not requiring the first holder (note lines 63-67 in col. 1), and the second end having a second holder for releasably holding a second cosmetic tool 12 (note lines 60-63 in col. 1) wherein the second holder provides for a friction fit between the second end and the second cosmetic tool 12 (note lines 63-65 in col. 1) and wherein the second cosmetic tool 12 is a conventional cosmetic tool designed for use as a separate unit not requiring the second holder (note lines 63-67 in col. 1). Although Bolser fails to disclose that the first holder has a different cross-sectional diameter than the second holder in order for the first and second holders to releasably hold respectively, the first and second cosmetic tools when the first cosmetic tool has a different cross-sectional diameter than the second cosmetic tool, it is considered that the configuration of the claimed holders is a matter of design choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed relative sized holders was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)). With respect to claim 4, Bolser further discloses that the cosmetic tools have removable caps 28 and 58. With regard to claim 5, Bolser additionally discloses that the caps 28 and 58 include a snap fit (note lines 37-42 in col. 2 and 56-57 in col. 3). With regard to claim 7, Bolser also discloses that the caps are composed of plastic

Art Unit: 3751

or metal (note lines 46-48 in col. 2 and Fig. 2). With respect to claim 8, Bolser additionally discloses that at least a portion of the cross-sectional shapes of the first and second caps has a combination of curved surfaces (note Figs. 1 and 2). With regard to claim 9, Bolser further discloses that at least a portion of the cross-sectional shape of the main body has a combination of curved surfaces (note Figs. 1 and 2). With regard to claim 10, Bolser also discloses that the main body, the first cap and the second cap have substantially the same cross-sectional shape (note Fig. 1). With respect to claim 11, Bolser further discloses that at least cap 28 has an exterior surface having a different cross-sectional shape than its interior surface (note Fig. 2).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Kay et al. Bolser further discloses a fluid applicator having cosmetic tools that contain fluids that are either both nail polishes (note lines 7-8 in col. 1) or nail polish and nail polish remover (note lines 19-21 in col. 1). Although Bolser fails to disclose that the cosmetic tool fluids can be a lip product or eye product, attention is directed to Kay et al. who disclose another fluid applicator wherein the fluid to be dispensed or applied is a cosmetic fluid such as nail polish, lip liner, eye liner, eye shadow liner, and lip gloss and cream (note lines 35-41 in col. 3). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to substitute for the nail cosmetic fluids of Bolser, the eye and lip cosmetic fluids as, for example, taught by Kay et al. wherein so doing would amount to mere substitution of one cosmetic fluid for another that would work equally well in the Bolser device.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Kay et al. as applied to claim 3 above, and further in view of Bunk. With regard to claim 6, although Bolser and Kay et al. fail to disclose that at least one of the caps includes a reflective outer surface, attention is directed to Bunk who discloses another cosmetic tool for a lip product which has a reflective outer surface 32, 44 on the end wall of the cap in order to allow those applying the lip product to view their lips and thus eliminate the blind application of the lip product (note lines 55-59 in col. 2 and lines 53-57 in col. 4). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to provide at least

Art Unit: 3751

one of the caps of Bolser with a reflective outer surface in view of the teachings of Bunk in order to allow those applying lip product to view their lips and thus eliminate blind application of the lip product.

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Cooper. With regard to claim 16, Bolser discloses a holder (constituted by coupling element 13) having the claimed features including a main body having a first end and a second end (note Fig. 2), the first end having a first holder for releasably holding a first cosmetic tool 11 (note lines 60-63 in col. 1) wherein the first cosmetic tool 11 is a conventional cosmetic tool designed for use as a separate unit not requiring the first holder (note lines 63-67 in col. 1), and the second end having a second holder for releasably holding a second cosmetic tool 12 (note lines 60-63 in col. 1) wherein the second cosmetic tool 12 is a conventional cosmetic tool designed for use as a separate unit not requiring the second holder (note lines 63-67 in col. 1). Bolser further discloses a fluid applicator having cosmetic tools that contain fluids that are either both nail polishes (note lines 7-8 in col. 1) or nail polish and nail polish remover (note lines 19-21 in col. 1). Although Bolser fails to disclose that the main body includes a reflective outer surface, attention is directed to Cooper who discloses another holder (constituted by clasp 541) for cosmetic tools for related personal items (note lines 26-29 in col. 1) which has a main body provided with a reflective outer surface or mirror 549 as an optional feature (note lines 22-25 in col. 7). It would have been obvious to one of ordinary skill in the cosmetic tool holder art at the time the invention was made, to provide the main body of the holder of Bolser with a reflective outer surface in view of the teachings of Cooper in order to provide the holder with an extra optional feature that may be useful to the user. With respect to claim 17, Bolser further discloses that the cosmetic tools have removable caps 28 and 58.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Cooper, as applied to claims 16 and 17 above, and further in view of Huang. Although Bolser fails to disclose that the holders include a threaded aperture for releasably holding a cosmetic tool having a matching threading, attention is directed to Huang who discloses another cosmetic

Art Unit: 3751

tool in which the cosmetic tool is held in the end of the main body or coupling unit 70 by a threaded end in order to removably engage and align the axes of the cosmetic tools (note ¶ 0024). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to threadingly mount the cosmetic tools within the main body of Bolser in view of the teachings of Huang in order to removably engage and align the axes of the cosmetic tools in a secure manner.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Cooper, as applied to claims 16 and 17 above, and further in view of Kageyama et al. ('693). Although Bolser fails to disclose the use of a chuck mechanism, attention is directed to Kageyama et al. who disclose another cosmetic tool (note lines 6-11 in col. 1) having a chuck 4 in which the replaceable article or tool 8 is mounted in order to allow for variations in the diameter or cross-sectional shape of the article or tool 8 (note lines 51-55 in col. 3). It would have been obvious to one of ordinary skill in the cosmetic tool art, at the time the invention was made, to provide at least one end of the main body of Bolser with a chuck mechanism for mounting the tool in view of the teachings of Kageyama et al. ('693) in order to allow for variations in the diameter or cross-sectional shape of a replaceable tool.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Cooper, as applied to claims 16 and 17 above, and further in view of Rosenthal. Although Bolser fails to disclose that at least one of the ends of the holder includes compressible material for releasably holding cosmetic tools having variable or different dimensions, attention is directed to Rosenthal who discloses another holder 12 having at least one end that includes a resilient, deformable, and thus compressible, member 36 at an end of the main body in order that sticks or tools of varying outer diameter can be supported therewithin (note lines 3-33 in col. 4 and Fig. 3). It would have been obvious to one of ordinary skill in the accommodating tool holder art, at the time the invention was made, to provide the main body of Bolser with a resilient, deformable, and thus compressible, member at least at one end in view of the teachings of Rosenthal in order that tools of varying outer diameter can be supported therewithin.

Art Unit: 3751

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Rosenthal. Bolser discloses a holder (constituted by coupling element 13) having the claimed features including a main body having a first end and a second end (note Fig. 2), the first end having a first holder for releasably holding a first cosmetic tool 11 (note lines 60-63 in col. 1) wherein the first holder includes an aperture or bore (note Fig. 2) for releasably holding a first cosmetic tool 11 having a curved portion at an end of the aperture (note Fig. 1) for receiving the first cosmetic tool 11 and wherein the first cosmetic tool 11 is a conventional cosmetic tool designed for use as a separate unit not requiring the first holder (note lines 63-67 in col. 1), and the second end having a second holder for releasably holding a second cosmetic tool 12 (note lines 60-63 in col. 1) wherein the second holder includes an aperture or bore (note Fig. 2) for releasably holding a second cosmetic tool 12 having a curved portion at an end of the aperture (note Fig. 1) for receiving the second cosmetic tool 12 and wherein the second cosmetic tool 12 is a conventional cosmetic tool designed for use as a separate unit not requiring the second holder (note lines 63-67 in col. 1). Although Bolser fails to disclose that the ends of the holder include compressible material for releasably holding cosmetic tools having variable or different dimensions, attention is directed to Rosenthal who discloses another holder 12 having at least one end that includes a resilient, deformable, and thus compressible, member 36 at an end of the main body in order that sticks or tools of varying outer diameter can be supported therewithin (note lines 3-33 in col. 4 and Fig. 3). It would have been obvious to one of ordinary skill in the accommodating tool holder art, at the time the invention was made, to provide the main body of Bolser with a resilient, deformable, and thus compressible, member at the ends in view of the teachings of Rosenthal in order that tools of varying outer diameter can be supported therewithin. Although Bolser fails to disclose that the first holder has a different cross-sectional diameter than the second holder in order for the first and second holders to releasably hold respectively, the first and second cosmetic tools when the first cosmetic tool has a different cross-sectional diameter than the second cosmetic tool, it is considered that the configuration of the claimed holders is a matter of design choice which a person of ordinary skill in the art would have found

Art Unit: 3751

obvious absent persuasive evidence that the particular configuration of the claimed relative sized holders was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bolser in view of Rosenthal, as applied to claim 21 above, and further in view of Cooper. Although Bolser fails to disclose that the main body of the holder includes a reflective outer surface, attention is directed to Cooper who discloses another holder (constituted by clasp 541) for cosmetic tools for related personal items (note lines 26-29 in col. 1) which has a main body provided with a reflective outer surface or mirror 549 as an optional feature (note lines 22-25 in col. 7). It would have been obvious to one of ordinary skill in the cosmetic tool holder art at the time the invention was made, to provide the main body of the holder of Bolser with a reflective outer surface in view of the teachings of Cooper in order to provide the holder with an extra optional feature that may be useful to the user.

Response to Arguments

11. Applicant's arguments filed August 27, 2004 have been fully considered but they are not deemed persuasive.

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 3751

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

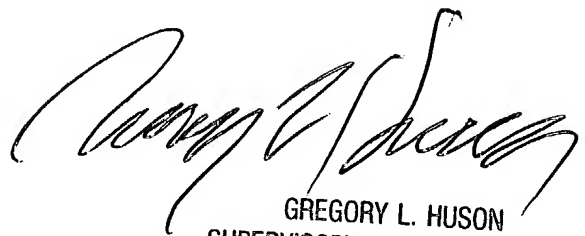
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. In mid to late November, 2004, the examiner's office will move to the new complex in Alexandria, Virginia. Upon moving to the new complex, the examiner's new telephone number will be 571-272-4894.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

October 18, 2004



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700